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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/681,770	10/07/2003	Edward S. Yeung	224711	8317
22885	7590	06/10/2004	EXAMINER	
MCKEE, VOORHEES & SEASE, P.L.C. 801 GRAND AVENUE SUITE 3200 DES MOINES, IA 50309-2721			ROSENBERGER, RICHARD A	
			ART UNIT	PAPER NUMBER
			2877	

DATE MAILED: 06/10/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/681,770

Applicant(s) ☒

YEUNG ET AL.

Examiner

Richard A Rosenberg

Art Unit

2877

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-34 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 1-34 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. ____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date 10/07/2003.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. ____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: ____.

1. This application is presented as a continuation of an earlier application 10/070,531. However, it appears that at least much of what is claimed in this application has no support in that earlier application. In particular, the earlier application appears to lack any support for treatment of the data from the detector array in which a peak value is selected and averaged with one of more other values, nor is there disclosure relating to selecting at least two digital values so as to minimize long time drifts in the pixel signatures. Thus this is not a proper continuation. Correction of the continuity data is needed.

As there is no support in the earlier application for the claimed subject matter, the effective filing date for the subject matter herein claimed the effective filing date is the filing date of this application, 7 October 2003, and not the effective filing date of the parent applications.

As set forth below, the specification and claims are not in proper correspondence under 37 CFR 1.75(d)(1). This makes it difficult to determine exactly which, if any, of the instant claims may have support in the parent application. Applicants should particularly point out the support in the instant specification, and specification of the parent applications, for any of the instant claims for which they believe they have adequate support and are thus entitled to the earlier filing date.

2. A new oath or declaration is required. The oath filed 7 October 2003 is defective because it refers only to the specification of the earlier application 10/070,531, and thus is not a proper oath for the subject matter added in the instant claims that is not supported in the earlier application.

3. The specification is objected to under 37 CFR 1.75(d)(1). The claims do not conform to the invention as set forth in the remainder of the specification. There is no support in the specification for some of the claimed subject matter, and to the degree that there may be disclosure for some of the claims in the body of the specification, it is in such different language than that in the claims that there is not clear support or antecedent basis in the description. The specification must be amended to include clear support and antecedent basis for what is now being claimed.

This is not a rejection for lack of disclosure (however, see below). The instant claims are part of the original disclosure filed in this application, regardless of any support they may or may not have in any earlier application. To the degree that the claims themselves provide support for their subject matter, there is support in this application for the claimed subject matter.

4. Claims 10, 20, 28 and 33 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the enablement requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention.

These claims set forth that pixels are “selected to minimize long time drifts of the pixel signals to generate a substantially flat baseline of the pixel signals”. The only disclosure for this appears to be the claims themselves; there appears to be no teaching of how to select pixels to accomplish this end. Merely stating that something can be done does not adequately disclose how to do it.

5. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(a) the invention was known or used by others in this country, or patented or described in a printed publication in this or a foreign country, before the invention thereof by the applicant for a patent.

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

(g)(1) during the course of an interference conducted under section 135 or section 291, another inventor involved therein establishes, to the extent permitted in section 104, that before such person's invention thereof the invention was made by such other inventor and not abandoned, suppressed, or concealed, or (2) before such person's invention thereof, the invention was made in this country by another inventor who had not abandoned, suppressed, or concealed it. In determining priority of invention under this subsection, there shall be considered not only the respective dates of conception and reduction to practice of the invention, but also the reasonable

diligence of one who was first to conceive and last to reduce to practice, from a time prior to conception by the other.

6. Claims 1-34 are rejected under 35 U.S.C. 102(a),(e), and (g)(2) as being anticipated by Doolen et al (US 6,462,816).

As set forth above, the effective filing date for what is herein claimed is 7 October 2003, which is the effective date of the invention by Applicants unless an earlier date can be established. The patent date of the Doolen et al patent is 8 October 2002, and its filing date is 21 July 2000, both of which are prior to the effective filing date, and effective date of invention, of the claimed subject matter in this application. Thus Doolen is available under at least 35 USC 102(a), (e), and (g)(2).

The instant claims are substantially a copy of the claims of the Doolen patent; see the preliminary remarks filed 7 October 2003. The claims are directed to, and appear to be intended to (as set forth in the preliminary remarks of 7 October 2003), directed to the same subject matter disclosed and claimed in the Doolen et al patent. In particular, Doolen et al discloses the claimed array or bundle of parallel capillary electrophoresis capillary tubes with the power source, the light source, photodetector comprising an array of photodetector elements arranged so that a plurality of pixels of the array receive light from each capillary tube, the analog to digital converter, and processor. The Doolen reference teaches processing the digital signals such that each output is a function of at least two

digital values (claim 1 of Doolen et al, for example), the selection of peak values and averaging four other values (claim 6 of Doolen et al, for example), and thus at least a second value (claim 8 of Doolen et al, for example), with the selected peak value, and selecting at least two digital values to minimize long time drifts of the pixel signals (claim 10 of Doolen et al, for example).

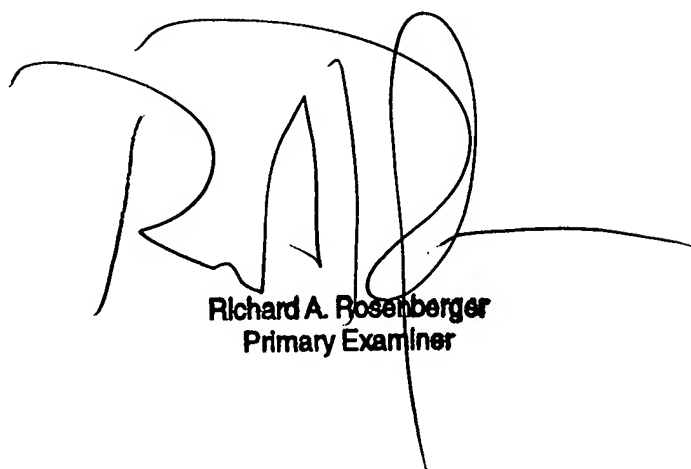
7. Gilby et al shows a similar arrangement. Note in particular column 8, lines 9-12 of Gilby which teaches "[i]n practice, signals from pixels corresponding to the same separation or reference channel will be combined to improve the signal-to-noise ratio of the analytical measurement."

8. Papers related to this application may be submitted to Group 2800 by facsimile transmission. The faxing of such papers must conform to the notice published in the Official Gazette, 1096 OG 30 (15 November 1989). The fax number is (703) 872-9306

Any inquiry concerning this communication or earlier communications from the examiner should be directed to R. A. Rosenberger whose telephone number is (571) 272-2428. The examiner's normal working hours are Monday through Friday, 8:00 AM to 4:30 PM.

Any inquiry of a general nature or relating to the status of this application should be directed to the Group receptionist whose telephone number is (703) 308-0956.

R. A. Rosenberger
4 June 2004



Richard A. Rosenberger
Primary Examiner